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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,864	11/17/2000	Brent D. McLaws	MC57-001	8952

21567 7590 06/02/2004

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EXAMINER	
KIM, CHRISTOPHER S	
ART UNIT	**PAPER NUMBER**
3752	

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/715,864	MCLAWS ET AL.	
	Examiner	Art Unit	
	Christopher S. Kim	3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Response filed March 11, 2004 is acknowledged.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

3. The amendment filed September 8, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: paragraph on page 1, beginning at line 14, insertion of the term "not" contradicts the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. Claims 24-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 24 and 33 recite the limitation "predetermined microdots." The

specification fails to teach any particular or predetermined microdots. It is unknown what "microdots" are being claimed by applicant.

5. Claims 24-35 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24 and 33 recite the limitation "predetermined microdots." The specification fails to disclose "predetermined microdots." The plain meaning of "microdot" is

> A copy or photograph that has been reduced to an extremely small size for ease of transport and purposes of security.
>
> The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company.

Another possibility is that "microdots" are considered micro-sized dots. In which case, any material, at it's microscopic level, can be considered to be made up of microdots. The metes and bounds of the claim cannot be determined.

Claim Rejections - 35 USC § 102

6. Claims 24-28 and 30-35 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Inglis (956,101).

Inglis discloses an identifier label applicator comprising: a container 1; a plurality of predetermined identifier labels (and base fluid) 2; a discharge aperture 12; a fluid intake 8; a dynamic fluid conduit 9, 21; a container valve 20.

7. Claims 24-29 and 31-35 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by McRitchie (3,236,459).

McRitchie discloses an identifier label applicator comprising: a container 18; a plurality of predetermined identifier labels (and base fluid) 190; a discharge aperture 130; a fluid intake (connection to tube 40); a dynamic fluid conduit 40, 182; a container valve 42.

Response to Arguments

8. Applicant's arguments filed March 11, 2004 have been fully considered but they are not persuasive.

Regarding the sentence,

> It is also desirable to provide an application in which the same components or parts are exposed to multiple different identifier labels because it may be difficult to clean or remove all the particles from one application before the next application is commenced.

applicant argues that anyone reading the sentence would recognize that it does not make sense if the same components or parts "are exposed". The sentence mere states that because of difficulty in removing all the particles it is desirable to expose components or parts to multiple different identifier labels. Adding the word "not" does not merely correct a typographical error or an obvious error. Rather, inserting the word "not" gives the sentence a completely opposite meaning. Applicant is changing the sentence to completely negate what was originally stated.

Applicant argues that the term "microdot" has been used in prior applications and is well known in the art. The term "microdot" is given its plain meaning and meaning as used in the art, but applicant's specification fails to disclose "predetermined microdots".

Applicant argues that the prior art does not disclose "drawing" the mixture. See Inglis, page 1, line 77. See McRitchie, for example, column 7, line 52, "aspiration".

Applicant argues that McRitchie does not disclose the steps of claim 33. Method steps of claim 33 are met in utilizing the device of McRitchie in spraying such fluids as disclosed in column 1, lines 45-55.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (703)

308-8336. The examiner can normally be reached on Monday - Thursday, 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Y. Mar can be reached on (703) 308-2087. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Christopher S. Kim
Primary Examiner
Art Unit 3752

CK
May 19, 2004